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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,656	01/30/2002	Yoshihisa Tsukada	0649-0821P-SP	3874

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

CHEA, THORL

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,656

Applicant(s)

TSUKADA ET AL.

Examiner

Thorl Chea

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to provide support as originally filed fails to provide support for the term "an emulsion layer" presented in claim 1.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claiming of "emulsion layer" is unclear for the specification fails to define such term.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP0911691 (EP'691).

EP'691 discloses a photothermographic material containing polymer latex which has been treated with a separation fractional polymer or has an ionic conductivity of up to 2,5 mS/cm. Note to the material on page 29 , claims 1-12. Since the polymer latex has been treated before the use thereof in the heat developable material, the material that would affect the property of the photothermographic material would be reduced. Note for instance on page 3 last paragraph, it is disclosed that "a polymer latex is treated with a separation functional polymer as by ultrafiltration is usually carried out plural time", and "is reduced ionic conductivity". Therefore, it asserted that the polymer latex taught in the EP'691 is more purified and the ionic group such as halogen ion would be reduced to very small amount included the halogen ion presented in the claimed invention, and the invention as claimed would be either anticipated or found obvious over EP'691 in the absence of showing otherwise.

8. Claims 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP0911691 (EP'691) as applied to claims 1-6 above, and further in view of Kato ('663), Harring et al ('449) and EP0803764 (EP'764).

Kato discloses a compound having a phosphoryl group in its molecule and the amine derivative as high contrast accelerator (abstract, and column 11, lines 17-20); Harring in column 16, lines 51-68, and columns 17-18 disclosed hydrogen donor as contrast enhancing compound; Milton in column 2 discloses a phosphoryl compound as antifoggant for silver halide material; EP'764 on page 12 a phenolic reducing agent of formula (I) of claim 9, including the compound having a phosphoryl group its molecule as reducing agent. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use a known reducing agent and the high contrast enhancer taught in Kao, Harring, Milton and EP'764 in the material of EP'691 with an expectation of achieving a material producing low fog, stable during storage and high image contrast.

Response to Arguments

9. Applicant's arguments filed May 02, 2003 have been fully considered but they are not persuasive. The applicants argue that none of the applied prior art of record teach or fairly suggest lowering the halogen ion concentration to 100 ppm in the latex used in the binder in the emulsion layer. This reduction of halogen ions can be performed by forming the latex with halide-free starting materials or by removing free halide from the latex once formed. It is further argued that the Examiner fails to provide factual and

technical grounds establishing that inherent feature necessarily flow from the teaching of prior art, not simply a possibility one.

The issue in the case is whether the latex taught in the EP'691 contains halide ions within the scope of 0-100 ppm and whether the use of latex having halide ions provide a photothermographic material with a results that would have been surprising to the worker of ordinary skill in the art. There is no different in latex composition of the EP'691 and that of the EP'691, except the halide content inherently carrying from the process of making the latex such as the starting material or additive used in the formation of the latex such as present in the disclosure on page 26. The specification on page 26 also discloses the reduction of halide ion can be conducted by purification of the polymer latex per se through a desalting step using, for examples, an ion exchange resin or dialysis memberane. The EP'691 discloses the treatment of polymer latex with a separation functional polymer or has ion conductivity of up to 2.5 mS/cm, and the element has a low fog of image, which remains stable during storage. The method such as ion exchange resin or dialysis memberane is taught in page 3 of the EP'691. Since the polymer taught in the EP'691 is treated the same process used in the present invention, it is asserted that the amount of impurities associated with the latex relatively low "ionic conductivity" which is from 0.05 to 2.5 mS/cm, and the amount ion including halide ions would encompass scope of the halide ions presented in the claimed invention. The Declaration presented in May 2, 2003 is insufficient to overcome the rejection over the EP'691 set forth above. The Declaration fails to show whether the polymer latex having ion conductivity of up to 2.5 ms/cm does not contain the halide ion

of not more than 100 ppm, and the material contains such polymer provide photothermographic material the results that would have been found unexpected to the worker of ordinary skill in the art. The Declaration fails to establish the relationship between the ionic conductivity and the halide ions. The results shown in the Declaration is irrelevant to the EP'691, but US Patent No. 6,174,663. Moreover, the statement of the improvement of the image preservability and the coating property is based on the counsel's assertion. Counsel's arguments cannot take the place of evidence. In re Greenfield, 571 F. 2d 1185, 197 USPQ 227 (CCPA 1978). Also, these results would have been found expected by the worker of ordinary skill in the art. The applicants are referred to page 28; Table 1 wherein the latex prepared by separation functional polymer treatment improves photographic properties such as fog, sensitivity and image stability.

10. The rejections in the previous office action set forth 1-8 in the previous office action is withdrawn in view of the applicants' argument.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea 
July 11, 2003


Thorl Chea
Primary Examiner
Art Unit 1752